

**REMARKS**

**I. Status of the Claims**

No claims are amended in this paper. Claims 18, 20-28, and 30-51 remain pending and under current examination. In the Final Office Action<sup>1</sup> mailed December 18, 2008, the Examiner maintained the rejection of claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a) as unpatentable over Mitsumatsu et al., WO 99/13830 (“Mitsumatsu”) in view of Oshima, JP 401009916A (“Oshima”) and Sebag et al., WO 98/03155 (also U.S. Patent No. 6,162,423) (“Sebag”). See Final Office Action at 2.

**II. Finality of Office Action**

In the December 18, 2008, Office Action, the Examiner marked the “non-final” check box on the Office Action summary form PTOL-326, but asserted on pages 5 and 6 that the Office Action was final. Applicants respectfully submit that the December 18<sup>th</sup> Office Action should not have been made final, at least because the Declaration Under 37 C.F.R. § 1.132 of Sandrine Decoster was filed with the Request for Continued Examination on December 1, 2008, and commented on by the Examiner for the first time in the Office Action dated December 18, 2008. Accordingly, Applicants respectfully request clarification in the next Official Communication issued from the Office, as to whether or not the December 18, 2008, Office Action was in fact a final Office Action.

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<sup>1</sup> The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

**III. Rejection under 35 U.S.C. § 103**

Applicants respectfully traverse the rejection of claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu in view of Oshima and Sebag. In the outstanding Office Action, the Examiner asserts that Mitsumatsu discloses “shampoo formulations comprising [triazoles]” but admits that Mitsumatsu “does not provide a specific example which concurrently uses stearyl alcohol and behenyl alcohol in the ratio as required by instant claim 18.” Final Office Action at 2-3. The Examiner asserts that “Oshima teaches a shampoo containing anionic and/or [amphoteric] surfactant and stearyl alcohol and behenyl alcohol as essential components,” and that “[t]he shampoo is ... ‘capable of imparting pearl luster to hair.’” Final Office Action at 3. The Examiner then asserts that “[i]t would have been obvious ... to modify the teaching of Mitsumatsu by using stearyl and behenyl alcohols in the weight ratio as motivated by Oshima.” *Id.* The Examiner then concludes that

Oshima already provides an example of a shampoo formulation disclosing the effective amount of and weight ratio of the fatty acids ... which would have motivated a skilled artisan to modify the teachings of Mitsumatsu.... Modifying the weight amount according to the combined teachings of the references would have been well within the skill of the art.

*Id.* at 5.

Applicants respectfully disagree. None of Mitsumatsu’s Examples 1-6 include both stearyl and behenyl alcohol, yet Mitsumatsu discloses that “Examples 1 through 6 have many advantages.” Mitsumatsu, Table labeled “Compositions” on page 42 and page 45, lines 9-10. Given this disclosure, one of ordinary skill in the art would not have considered it obvious to modify Mitsumatsu’s teachings to include both stearyl and

behenyl alcohol since the “many advantages” disclosed by Mitsumatsu were attributed to the use of a single alcohol, rather than a stearyl and behenyl alcohol mixture.

Further, even if the teachings of Oshima and Mitsumatsu were combined in the manner proposed by the Examiner, Mitsumatsu only discloses using 0.1-0.2% stearyl alcohol and 0.1% behenyl alcohol. Id., Table labeled “Compositions” on page 42. Oshima requires 0.5 to 5% stearyl alcohol and 0.75 to 7.5% behenyl alcohol. Oshima, page 4, lines 15-16. Oshima’s required amounts for stearyl and behenyl alcohol are thus substantially greater than the amounts disclosed by Mitsumatsu. Given this significant difference, one of ordinary skill in the art would not have considered it obvious either to modify Mitsumatsu to use the combination of stearyl and behenyl alcohol in the percentages of stearyl and behenyl alcohol required by Oshima.

Further, the proposed combination of Mitsumatsu and Oshima, upon consideration of each reference as a whole, would be limited by the requirements disclosed by each of Mitsumatsu and Oshima – namely that the composition must contain triazoles to achieve the optical brightening required by Mitsumatsu, and the composition must contain the four essential components of Oshima (a specific amphoteric surfactant, polypeptide, stearyl alcohol, and behenyl alcohol). Since the nature of the required components of each reference are divergent, there would be no reasonable expectation for success in combining Mitsumatsu and Oshima. It is precisely due to this lack of expectation of success that there would have been no motivation to make the combination suggested by the Examiner.

Sebag does not overcome the deficiencies of either Mitsumatsu or Oshima. Sebag does not disclose a composition using stearyl alcohol, behenyl alcohol, or both.

Example 1 of Sebag includes stearyl alcohol oxyethylentated with ethylene oxide, and no other Examples of Sebag use any form of stearyl alcohol. Sebag, col. 17, lines 36-60. None of Sebag's Examples include behenyl alcohol, and none include a combination of stearyl and behenyl alcohols.

Further, any composition based on the combination of Mitsumatsu, Oshima, and Sebag must still meet the requirements of Mitsumatsu and Oshima. Indeed, such a combination must include the triazoles of Mitsumatsu and the four essential components of Oshima. However, there is no reasonable expectation that such a combination would actually satisfy the requirements of either Mitsumatsu or Oshima. And there is no reasonable expectation that combining the teachings of Mitsumatsu and Oshima would successfully achieve Applicants' claimed invention.

For at least the reasons presented above, Mitsumatsu, Oshima, and Sebag do not disclose or suggest Applicants' claimed invention as recited in independent claims 18, 47, 49, and 50. Claims 18, 47, 49, and 50, and claims 20-28, 30-46, 48, and 51 which depend from claim 18, 47, or 50, should all be allowable over Mitsumatsu, Oshima, and Sebag. Applicants therefore request withdrawal of the rejection of claims 18, 20-28, and 30-51.

#### **IV. Declaration filed December 1, 2008**

Applicants filed on December 1, 2008, a Declaration under 37 C.F.R. § 1.132 setting forth a side-by-side comparison between a composition having a C18:C22 fatty acid ratio of 0.19, which is within the claimed ratio range, with a composition having a C18:C22 fatty acid ratio of 0.085, which is outside the claimed ratio range. This direct comparison showed that the viscosity of the inventive composition was less temperature

dependent than the viscosity of the comparative composition. See Declaration at paragraph 5.

As emphasized in the previous response, this direct comparison highlighted the fact that similar compositions, *i.e.*, compositions containing the same stearyl and behenyl alcohols components but in differing amounts, would not necessarily have similar properties. Given the level of unpredictability demonstrated in the Declaration, nothing in the prior art relied upon by the Examiner, when considered as a whole, would have led to the expectation of variable temperature-dependant viscosities that is shown in the Declaration.

The Examiner asserted that the Declaration does not place the application in allowable condition. Final Office Action at 4. Further, the Examiner asserted that Oshima “provides an expectation of the result indicated in the declaration because the reference teaches that the ratio of 1:1.5 - 4.5 provides ‘excellent’ storage stability. *Id.* at 4-5. Applicants respectfully disagree.

Oshima does not provide an expectation of the result indicated in the Declaration. Oshima discloses that Comparative Examples 6 and 7 showed poor performance and could not accomplish the object of Oshima’s invention. Oshima, page 11, third line under Table 3 through page 12, line 2. Comparative Example 6 of Oshima has a stearyl alcohol to behenyl alcohol ratio of 1:1, outside the required range for Oshima but within Applicants’ claimed range. Id., page 10, Table 2. Comparative Example 7 of Oshima has a ratio of 0.6 to 8.0, which is 0.075, also outside Oshima’s required range but outside Applicants’ claimed range. Since both Comparative Examples 6 and 7 showed poor performance as judged by Oshima, Oshima does not,

in contrast to the Examiner's assertion, provide the "expectation of the result" in the Declaration. Instead, Oshima clearly evidences the unpredictability that exists in the art.

Moreover, Oshima discloses that when the quantity of polypeptide, an essential component, is out of range, as shown in Oshima's Comparative Examples 8-10, there is poor performance and the objective of the invention cannot be accomplished. *Id.*, page 11, Table 3 and third line under Table 3 through page 12, line 2. Oshima's Examples 1-8 all contain the apparently essential component polypeptide. Oshima therefore does not provide any expectation of success from modifying the teachings of Oshima with regard to use of polypeptide in an attempt to achieve Applicants' claimed invention.

Applicants submit that the Declaration therefore demonstrates the unpredictability associated with the combination suggested by the Examiner, and that Mitsumatsu in view of Oshima and Sebag would not have led to the expectation of variable temperature-dependant viscosities as shown in the Declaration. Therefore, for at least these additional reasons, Mitsumatsu in view of Oshima and Sebag does not disclose or suggest Applicants' claimed invention as recited in independent claims 18, 47, 49, and 50. Claims 18, 47, 49, and 50, and claims 20-28, 30-46, 48, and 51 which depend from claim 18, 47, or 50, should therefore be allowable.

**V. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, appearing to read "Mark D. Sweet", written over a horizontal line.

Dated: March 18, 2009

By: \_\_\_\_\_  
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